

Office Action Summary

Application No.

10/813,153

Applicant(s)

LEBLANC ET AL.

Examiner

JYOTHSNA A. VENKAT

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☒ Informer Disclosure Statement(s) (PTO/SB/02)
Paper No(s)/Mail Date 8/18/09
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 3/10/10
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of amendment filed on 1/6/10 ; remarks and terminal disclaimer filed 12/9 /09 and IDS filed on 8/18/09.

Status of claims

Claims 1-16, 18-22 and 29-30 are cancelled. Claims 17 and 23-28 are pending in the application.

In view of the amendment , the rejection of claims 17 and 23-28 are rejected under 35 U.S.C. 112, first paragraph is hereby withdraw.

The following rejections are maintained.

Claim Rejections - 35 USC § 112

Claims 23-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "at least about" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, one of ordinary skill in the art would not be reasonably apprised of the scope of the invention, because one of skill will not be able to determine which term is in control. The claims lack clarity as to whether "at least" (a lower limit) or about "(broadening limitation, both higher and lower) it is unclear what controls the metes and bounds of the phrase "at least about". *Amgen, Inc. v. Chugai Pharmaceutical co., 18 USPQ 2D 1016.*

The term "greater than about" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would

not be reasonably apprised of the scope of the invention, because one of skill will not be able to determine which term is in control. The claims lack clarity as to whether "greater" (a lower limit) or about "(broadening limitation, both higher and lower) it is unclear what controls the metes and bounds of the phrase "greater than about".

Response to Arguments

Applicant's arguments filed 12/9/09 have been fully considered but they are not persuasive.

Applicants' argue that *In Amgen* the expression "at least 120,000" was cancelled and new claim language "at least about 160,000" was submitted. The court found the addition of the word "about" to constitute an effort to recapture a mean activity somewhere between 120,000, which the patent examiner found was anticipated by the prior art and 160,000 claims which were previously allowed. In the instant fact situation the term "at least about" was used *ab initio* in the specification and claims, and effort to recapture was not an issue.

In response to the above argument, specification fails to define the scope for the expression "about" and claims recite "at least and also about and one of skill will not be able to determine which term is in control.

The same is true for the expression "no more than about".

The scope of expression is not defined and one of ordinary skill in the art could not interpret the metes and bound of the claims so as to understand how to avoid infringement.

Claim Rejections - 35 USC § 103

1. Claims 17 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 6,010,686 ('686) and 5,626,840 ('840) and 6,264,933 ('933) and 6,039, 935 ('935).

Instant application is claiming a method of treating skin comprising:

1. Neutralized, solubilized anionic polyurethane

2. Solvent

3. Second polymer. The specification defines "solubilized urethane" as urethane being soluble in solvent.

4. Water

Patent '686 teaches cosmetic composition using a polymeric system, which contains one film-forming polymer and use of this composition on the skin. See the abstract, see col.1, ll 1-16.

Patent '686 at col.2, ll 10-26 teaches:

10 The composition according to the invention makes it possible to obtain a homogeneous film which has a light texture and remains comfortable to wear all day long. The film is not at all sticky, while being soft, supple, elastic and flexible on the skin; it follows the movements of the support on which it is applied without cracking and/or lifting off. It adheres completely to the lips. The composition according to the invention therefore is particularly advantageous as a composition for application to the lips, especially as lip rouge. The composition according to the invention also is particularly advantageous as a composition for application as an eyeliner.

20 Furthermore, the film obtained in accordance with the present invention can be very glossy or more or less matte, depending on the nature of the particular constituents of the composition. This results in a wider range of make-up products which can be made glossy or matte at will.

Patent at col.2, ll 35-40 teaches various polyurethanes and this includes anionic polyurethane. Patent at col.4, ll 10-24 teaches:

- 10 In the present description "dispersion of film-forming polymer" is intended to mean a dispersion capable of forming a film, including or not including a coalescing agent.
- 15 The solids content of the aqueous dispersions according to the present invention may range from 5 to 60% by weight, and preferably range from 30 to 40% by weight.
- The composition of the invention may include from 1 to 60% by weight, preferably from 5 to 40% by weight, of dry solids of film-forming polymers.
- 20 The particle size of the polymers in aqueous dispersion may range from 10 to 500 nm and preferably ranges from 20 to 150 nm, which makes it possible to obtain a film which has a remarkable gloss.

Patent at col.4, ll 40-45 teaches plasticizing agent and this includes water soluble solvents and water insoluble solvents. Patent at col.4, ll 50-62 teaches various glycol derivatives. Patent at col.5, ll 22-30 suggests adding additives like acrylic polymer into the compositions. See examples and see claim 2 for anionic polyurethane. Patent does not teach neutralized polyurethane.

Patent '840 teaches claimed anionic solubilized neutralized polyurethanes. Patent '840 teaches anionic polyurethanes which can be soluble or dispersible in water. See the abstract, and see col.2, ll 16-19 for the weight percent. Patent at col.5, lines 52-63 teaches:

Neutralization renders the polymers soluble or dispersible in water for easy formulation into aqueous hair sprays (and thus contributes to removability). The neutralized polymers can be formulated solely in water as the solvent, or the solvent system can be a blend of polar organic solvent and water. Typically, the organic solvent will be an alcohol or ketone. Particularly suitable solvents are low boiling alcohols that are compatible with other components in the hair fixative composition, for example, C₁-C₄ straight or branched chain alcohols. Exemplary polar solvents are ethanol, propanol, isopropanol, butanol, acetone, dimethyl-ether and dimethoxymethane.

The difference between these patents and the instant application is they do not teach second polymer and the amount of water, which is from about 61% to about 76 %.

However patent '933 teaches film forming polymer and this includes anionic polyurethane as the film forming polymer. See col.2, line 34 and see col.4, ll 5-8 for the weight percent of the polymer. Patent '933 teaches various solvents at col.4, ll 17-25. Patent at col.4, ll 30-050 teaches additional film forming polymer can be added into the compositions and this includes polyacrylates and polymethacrylates claimed in the instant application.

Patent '935 teaches sunscreen compositions. Sunscreen compositions are used for treating skin. Patent '935 teaches at col.2, line 45 amount of water. The amount of water claimed is within the weight percent taught by patent.

Accordingly it would be obvious to one of ordinary skill in the cosmetic art to prepare compositions of patent '686 and **substitute** the anionic film-forming polymer with another functionally equivalent film forming polymer, which is neutralized solubilized anionic polyurethane of patent '840 and add additional film forming polymer (polyacrylate or polymethacrylate) taught by patent '933 in analogous cosmetic compositions and add the amount of water taught by patent '935. One of ordinary skill in the cosmetic art would modify the

compositions of patent '686 by using neutralized and solubilized anionic polyurethane since these anionic polyurethanes are soluble in water for easy formulations. This is a prima facie case of obviousness.

Response to Arguments

Applicant's arguments filed 12/9/09 have been fully considered but they are not persuasive.

Applicants' argue that patent '686 does not teach or suggest neutralized or solubilized polyurethane and patent does not teach second polymer and patent does not teach method for treating skin for SPF protection, water resistance on skin with compositions as presently claimed.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., method for treating skin for SPF protection, water resistance on skin) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants' argue that De la Poterie is directed towards dispersion of particles to make a film on skin, while Thomaidis is directed towards polyurethanes with carboxylate functionality for use as hair fixatives, and Bodelin teaches cosmetic compositions for keratin fibers (hair - mascara for Eyelashes). The effect of compositions, known to be effective for use on hair, would not be predictable to one of ordinary skill in the art when used on skin. One of ordinary skill in the art would know the function the compositions of Thomaidis and Bodelin performed on hair, but would not be able to assume that those compositions would function in any particular way on

skin, and the result of the combination of those compositions would not be predictable. The combination could therefore not be considered obvious. *KSR International Co. v. Teleflex Inc.*, 550 US 398.

A reference is analyzed using its broadest teachings. MPEP 2123 [R-5]. "[W]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious". KSR v. Teleflex, 127 S.Ct. 1727, 1740 (2007)(quoting Sakraida v. A.G. Pro, 425 U.S. 273, 282 (1976)). "[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious", the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." (Id). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." KSR v. Teleflex, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that "[a] person of ordinary skill is... a person of ordinary creativity, not an automaton." Id at 1742.

Therefore one of ordinary skill in the cosmetic art would prepare compositions of patent '686 and **substitute the anionic film-forming polymer** with another functionally equivalent film forming polymer, which is **neutralized solubilized anionic polyurethane of patent '840** and add additional film forming polymer (polyacrylate or polymethacrylate) taught by patent '933 in analogous cosmetic compositions and add the amount of water taught by patent '935. One of ordinary skill in the cosmetic art would modify the compositions of patent '686 by using

neutralized and solubilized anionic polyurethane since these anionic polyurethanes are soluble in water for easy formulations .

Double Patenting

Claims 17 and 23-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4 and 6-12 of copending Application No. 10/116,368 (corrected the serial number). Although the conflicting claims are not identical, they are not patentably distinct from each other because copending application is claiming the skin care composition and instant application is claiming method of treating skin using the same skin care compositions. It is obvious to use the skin care compositions for treating skin.

Applicants' are notified that the terminal disclaimer submitted is proper (TD) , however due to an inadvertent typographical error the serial number recited in previous action was different and as such the TD was not entered. This error is regretted. The TD will be entered upon mailing of this office action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EYLER YVONNE (BONNIE) can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619